

REMARKS

The application has been amended and is believed to be in condition for allowance.

The acknowledgement of the claim to foreign priority document French Application FR 0311364 is gratefully appreciated.

There are no formal matters pending.

Amendments to the Claims

Claim 1 is amended to include numerals to more clearly indicate the elements of the card body.

New dependent claims 29 and 30 depend respectively from independent claim 1 and dependent claim 28. The new claims find support in claims 7 and 8 as originally filed, as well as the specification and the drawing figures as originally filed. The new claims are not believed to introduce new matter.

Claim 28 is also amended to clarify the structural features of the invention; the amendments to claim 28 find support in the specification and the drawing figures as originally filed (e.g., Figure 1, element 12; page 4, lines 19-20; page 5, lines 20-29) and is not believed to introduce new matter.

Substantive Issues - Section 103

The Official Action rejected claims 1, 7-8, 10, 12-15, and 24-28 under 35 USC 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065; "NISHIKAWA") in view of Smith et

al. (US 7,065,195; "SMITH") and Pentz et al. (US 6,471,127; "PINTZ").

The Official Action rejected claims 3-6, 18 and 20-23 under 35 USC 103(a) as being unpatentable over NISHIKAWA, SMITH and PENTZ, and further in view of Lubking (US D498,788; "LUBKING").

The rejections are respectfully traversed for at least the reasons that follow.

Claim 1

The Official Action contends that NISHIKAWA, modified by SMITH and PENTZ discloses all the limitations of claim 1. Applicant respectfully disagrees. It is respectfully submitted that none of NISHIKAWA, SMITH or PENTZ, either individually or in combination, teach or suggest all the features recited in claim 1.

I.

The Official Action offers Figure 47B of NISHIKAWA as teaching a microcircuit card 41 precut in a card body 40 and a token 43 precut in the card body, adjacent to the microcircuit card and carrying visual information. NISHIKAWA's Figure 47B is reproduced below, for the Examiner's convenience.

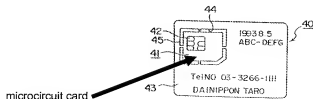


FIG. 47B

As can be seen, the card is in two parts: an IC card 41 attached to a card base 43, "from which only IC carrier 41 is taken off to be used," (column 1, lines 40-45).

The Official Action contends that element 43 in the NISHIKAWA's Figure 47B discloses, "a token precut in the card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body". However, NISHIKAWA only discloses element 43 as a "card base... for IC card 40... from which only IC carrier 41 is taken off to be used," (column 1, lines 43-45). It is respectfully submitted that NISHIKAWA fails to teach or suggest the token.

Claim 1 recites a card body comprised of i) a microcircuit card precut in the card body, and ii) a token precut in the card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body. Claim 1 further recites iii) a remainder portion of the card body removably joined to both the microcircuit card and the token (emphasis added).

Figure 47B clearly discloses only a single element, IC carrier 41, that is precut in the card body 40 (IC carrier 41 being a substrate for an embedded IC module 42 such as for a SIM for a portable telephone; see column 1, lines 28-23). There is nothing in NISHIKAWA's Figure 47B that teaches or suggests a token with all the features recited by claim 1 (i.e., a second element), particularly none that is "precut" and "in" the card

body 40 that also carries visual information, extends up to a corner of the card body, and is adjacent to the microcircuit card. That is, no element in Figure 47B teaches all these features recited to the token.

Hence, it is respectfully submitted that NISHIKAWA does not teach the token as recited by claim 1.

The Official Action further contends that NISHIKAWA's Figure 47B suggests an invention for providing a combined SIM card and a telephone calling card. In support, the Official Action implies that the visual information, provided on the portion 43 of NISHIKAWA's card remaining after the IC carrier 41 is removed, teaches or suggests information corresponding to a calling card. It is understood that the Official Action takes the position that the combination of this information on the portion 43 of Figure 47B satisfies the recitation of a "token" in claim 1.

However, as indicated above, nothing in Figure 47B other than the IC carrier 41 teaches or suggests a portion that is "precut" and "in" a card body. In the event that the rejection over this reference is maintained, it is respectfully requested that the token precut in the card body adjacent to a microcircuit card be identified with specificity within the disclosure of NISHIKAWA.

Further, no passage or other evidence is offered to support that NISHIKAWA in any way suggests a telephone calling

card. Applicant has carefully reviewed the reference, and was not able to identify any disclosure suggesting a calling card.

As to the information printed on portion 43 of Figure 47B, NISHIKAWA makes no disclosures. It is noted that NISHIKAWA designates Figure 47B is as prior art to further disclosures. However, even these further disclosures, which are not offered in the Official Action in rejecting the claims, fail to teach or suggest information corresponding to a calling card.

On the contrary, NISHIKAWA discloses "identification information of [the] individual card is printed on the sheet frame 13 and on the base 11c of the IC carrier 11 by an ink jet printer or the like," (column 25, lines 25-27). The identification information may be a serial number or other information like a registration number (column 25, lines 61-65). The identification information may even include a bar code or magnetic information like a magnetic stripe (column 21, lines 42-47; column 26, lines 3-5).

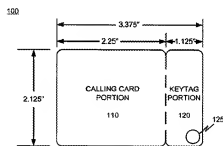
However, in every instance, the information is specifically directed to the IC card of the IC carrier, such as to aid in the production process (column 21, lines 42-47), and/or to associate the IC card with a subscriber should the IC card be lost or damaged (column 26, lines 11-16). There is no hint or suggestion anywhere in NISHIKAWA that any of the information provided on the card in any way behaves like that provided on a calling card.

It is therefore respectfully submitted that NISHIKAWA fails to teach a token precut in a card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body, the token carrying visual information and including a hole through a thickness of the token, as recited in claim 1.

II.

The Official Action concedes that NISHIKAWA fails to teach a remainder portion of the card body removably joined to both a microcircuit card, and a token with a hole, as recited by claim 1.

The Official Action offers Figure 1A of SMITH as teaching these features. Figure 1A of SMITH is reproduced below, for the Examiner's convenience.



**FIG. 1A**

The Official Action identifies key tag portion 120 as teaching the remainder portion recited in the claim, stating that a "remainder portion," in general, can be considered any portion of the card body that remains after removal of the microcircuit card. The Official Action contends that one of skill would have been motivated by SMITH to modify NISHIKAWA in order to provide a

means of allowing a user to conveniently carry a calling card number on a key ring.

However, no microcircuit card is disclosed in SMITH's Figure 1a, and no calling card number (or any other calling card information) is disclosed in NISHIKAWA's Figure 47B.

As indicated above, NISHIKAWA only discloses the card body 40 as a substrate for transporting and delivering the IC carrier 41 (column 1, lines 46-48). No disclosure is found in NISHIKAWA that the remaining portion 43, after removal of the IC carrier 41, in any way teaches or even suggests a calling card.

Further NISHIKAWA teaches that the IC carrier 41 would be set in a portable telephone 50 "whereby he or she can use it" (column 2, lines 24-30), presumably to enable the portable telephone to make and receive calls. NISHIKAWA makes no disclosure making any teaching or suggestion that, once a user's portable telephone is activated with the SIM of the IC carrier, one would have any use of a calling card or even a calling card number. On the contrary, one of skill would reasonably presume that a portable telephone activated with the IC carrier would be completely capable of making calls without requiring a calling card.

Further, SMITH makes no teaching of a microcircuit card. SMITH's Figure 1A comprises only two parts, just like Figure 47B of NISHIKAWA. The two parts of SMITH's card, as in Figure 1A, are i) a calling card portion 110 with a magnetic

strip so that card portion 110 may be swiped through a magnetic card reader, and ii) a key tag portion 120 that provides account and/or promotional information (see column 3, lines 24-33 and lines 60-62; column 9, lines 22-30).

Hence, at best, SMITH teaches two calling cards 110 and 120 separably connected to one another, wherein only the card 110 has a magnetic stripe.

Therefore, even if one of skill would have had reasonable motivation to modify NISHIKAWA with SMITH as proposed, the resulting device fails to yield the invention as claimed.

### III.

It is further respectfully submitted that no reasonable motivation would have existed at the time the invention was made to have modified NISHIKAWA with SMITH as proposed by the Official Action.

Again, NISHIKAWA fails both to teach or suggest a calling card, and SMITH fails both to teach or suggest a micro-circuit card. The Official Action contends that NISHIKAWA suggests an invention for providing a combined SIM card and a telephone calling card removable from each other. However, as indicated above, no disclosure in NISHIKAWA teaches or suggests a calling card.

The Official Action further contends that SMITH suggests an invention suggests an invention for providing a combined keytag portion and miniature telephone calling card



portion that are removable from each other. However, it is respectfully submitted that no reasonable motivation would have existed at the time the invention was made to modify NISHIKAWA with SMITH.

On the contrary, as indicated above, NISHIKAWA teaches a device for delivering a SIM card to be used to enable usage of a portable telephone. That is, the SIM card enables one to make phone calls on the portable telephone to which the SIM card is attached.

In contrast, SMITH provides a device for providing information that would be entered into a working telephone (e.g., via a keypad) in order to activate pre-paid minutes for making phone calls on a telephone network (see column 3, lines 13-14, 26-33 and 46-53).

There is no suggestion in any of NISHIKAWA or SMITH that a device for delivering a SIM card for activating a portable telephone would in any way benefit from having the features of a calling card. Based on the disclosures of these references, there is nothing on the record that would even suggest that such a combining a SIM card with a calling card number would even be obvious to try.

Further, NISHIKAWA teaches that information provided on the card base 43 is directed either to facilitate the production process (column 21, lines 42-47) or associate the IC card with a subscriber should the IC card be lost or damaged (column 26,

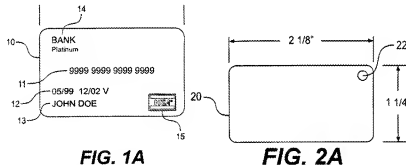
lines 11-16). Were this information to be removed in favor of calling card information as taught by SMITH, NISHIKAWA would be rendered unsatisfactory for these applications, particularly in the matching operation during production (column 22, lines 8-18).

It is therefore respectfully submitted that the invention claimed is non-obvious in view of NISHIKAWA and SMITH.

#### IV.

Further, the Official Action concedes that NISHIKAWA and SMITH fail to teach the hole included with a token (based on the above, the two references teach a hole through a remainder portion), but offers a third reference PENTZ as teaching the hole being in a corner of a token in a vicinity of the microcircuit card. PENTZ discloses a generally rectangular card 20 (column 5, line 16), configured as a bank or credit card (column 4, lines 51-67), that may comprise a computer chip (column 5, line 14) and also comprises bank-related visual information (Figure 1A).

Figures 1A and 2A of PENTZ are reproduced below, for the Examiner's convenience.



The Official Action contends that PENTZ would have taught one of skill to modify NISHIKAWA to provide a means

(presumably, a hole) of allowing a user to conveniently carry a telephone calling card on a key ring. However, it is readily apparent from the illustration above that PENTZ teaches only a single part that, at best, would suggest an inseparably combined microcircuit card and token with visual information, featuring a hole for a keyring.

Further, it is respectfully submitted that one of skill would have had no reasonable motivation to have modified NISHIKAWA with PENTZ, at least because there is no disclosure in NISHIKAWA teaching or suggesting that a user would want to retain NISHIKAWA's card base 43, on a key ring or on anything else. Based on NISHIKAWA's disclosure, one of skill would have readily understood that the card base 43 has no value once the IC carrier 41 is taken off and placed into a portable telephone.

Yet further, the information printed on the card base 43 of NISHIKAWA is incompatible with the information included on the PENTZ card (credit/bank card information). As with SMITH above, modifying NISHIKAWA to replace the information on the card base 43 with bank or credit account information would render NISHIKAWA unsatisfactory for production (column 22, lines 8-18) or for identifying an IC card with an associated user in case of loss or damage (column 26, lines 11-16).

It is therefore respectfully submitted that one of skill would not have had any reasonable motivation to have

modified NISHIKAWA with PENTZ, as proposed by the Official Action.

V.

Based at least on the reasons set forth above, it is respectfully submitted that the invention recited in claim 1 is patentable over NISHIKAWA, SMITH, and PENTZ.

VI.

It is also respectfully submitted that claims depending from claim 1 are patentable over NISHIKAWA, SMITH, and PENTZ at least for depending from a patentable parent claim.

For example, as to claim 12, PENTZ only discloses a 1-part card. Therefore, PENTZ cannot anticipate the feature of a hole located in a corner of a token located in a vicinity of a microcircuit card (which, according to claim 1, is a separate part from the token).

As to claims 14 and 15, none of the cited prior art teaches or suggests a multipart card comprising two separate data portions. In particular, there is no teaching or suggestion of a microcircuit card removably coupled to a contactless device or a RFIO device. Nor is there any teaching or suggestion to motivate one to modify a device as taught by NISHIKAWA to include these features.

As to claims 7 and 8, it is respectfully submitted that the recited formats for the card body and the microcircuit card respectively are incompatible with any combination of NISHIKAWA

and SMITH since both 1D-1 and 1D-000 formats set a given location for a common corresponding microcircuit. The combination of these features require a specific location of the microcircuit card with respect to the large card. One of skill in the art would have readily recognized that the added expense to further rework the device in NISHIKAWA would not be justified in view of a substrate for carrying an IC card that is without value after the IC card is removed for use.

As to claim 10, the Official Action offers element 75 of NISHIKAWA Figure 38 as disclosing a magnetic strip on a card. However, Figure 38 corresponds to the back side of the card of Figure 36A, and NISHIKAWA discloses that strip 75 is located on a film 16 which extends along the card sheet as well as along the small card (e.g., column 26, lines 35-38). At the very least, this embodiment has nothing to do with the prior art embodiment at Figure 47B. Further, the card sheet of NISHIKAWA (in which the small card is precut) does not disclose a token, and the strip 75 is intended to be used in compliance with the ISO standard wherein an entire length of the strip is required (i.e., taking the card apart as in the proposed combination would render the strip unsatisfactory; see Figure 38; column 27, lines 14-24).

As to claim 28, it is firstly noted that claim 28 is amended to clarify the structure of the recited feature. Further, the element 45 identified by the Official Action in Figures 47A-B refers to L-shaped bridges that are left over after

slits 44 are formed in the card base 43, from which the IC carrier 41 is taken off to be used (column 1, lines 41-45). This disclosure fails to teach or suggest an L-shaped residual portion extending along outermost sides of the card body to form three outermost corners of the card, as recited by amended claim 28.

Further as to dependent claims 3-6 and 18, it is noted that the Official Action concedes that none of NISHIKAWA, SMITH, or PENTZ teach or suggest the recited features. The Official Action offers design patent LUBKING as teaching a token extending to only one corner of a card body and wherein the corner has a furthest distance from the microcircuit card.

However, as with NISHIKAWA and SMITH, LUBKING is limited to a two-part device and makes no teaching of a microcircuit card. Thus, LUBKING fails to teach or suggest a card body including a microcircuit card, a token and a remainder portion, either on its own or in view of the other cited references.

#### VII.

Based on the reasons set forth above, it is respectfully submitted that claim 1 and claims depending therefrom are patentable.

Withdrawal of the rejections of claims 1 and claims depending therefrom is respectfully requested.

Independent Claims 21-23

It is respectfully submitted that independent claims 21-23 are patentable at least for the reasons set forth above as to claim 1 in view of NISHIKAWA, SMITH, PENTZ, and LUBKING.

Further, it is respectfully submitted that LUBKING is not pertinent to NISHIKAWA.

Again, NISHIKAWA is directed to a card base for safely transporting an IC carrier card so that a user will later remove the IC carrier card and install the IC carrier card into a portable electronic device. LUBKING, in stark contrast, discloses what is apparently a credit card or transaction card (e.g., see the expiration date included along with the personal identification information, e.g., Figures 1, 2, and 8) provided in a large format and a small format, wherein the small format is removably included within the larger format. There is nothing in any of the drawings of this design patent D498,788 that even remotely suggests an IC carrier card.

In combination with NISHIKAWA, one of skill would have arrived at a card as in Figure 47B, but with a removable duplicate of the card body 43 in small format included within the card body 43.

If the small format duplicate were to substitute for the IC carrier card, NISHIKAWA would have been rendered unsatisfactory for its intended purpose of transporting said IC

card. Accordingly, one of skill would have had no reasonable motivation to have made this modification.

Further, as the information provided on the card body of NISHIKAWA is of little to no use to the user (except in the event of loss of the IC carrier card), there is no reason to include the information of card body 43 twice on two different separable objects, particularly as one is a small format that is more easily lost itself, and the remaining body 43 after the removal of both the IC carrier card and the small format card would be in poor structural condition (and therefore more likely by cast away). Hence, again, the proposed modification with LUBKING renders NISHIKAWA unsatisfactory.

It is therefore respectfully submitted that independent claims 21-23 are patentable in view of NISHIKAWA, SMITH, PENTZ, and LUBKING. Accordingly, withdrawal of the rejections of claims 21-23 is respectfully requested.

#### Conclusion

From the foregoing, it will be apparent that Applicant has fully responded to the August 19, 2010 Official Action and that the claims as presented are patentable. In view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, the Examiner is invited to telephone the attorney for Applicant at the number set forth below if the Examiner is of the opinion that



further discussion of this case would be helpful in advancing prosecution.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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